

Remarks

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of parent U. S. Patent No. 6,722,569 to Ehrhart, et al. ("Ehrhart '569"). Claims 3-11 and 13-21 are rejected under 35 U.S.C. §112 as lacking proper antecedent bases.

In rejecting a claim for obviousness-type double patenting, the Examiner must:

- A. Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- B. Determine the differences between the scope and content of the patent claim and the prior art as determined in "A" and the claim in the application at issue;
- C. Determine the level of ordinary skill in the pertinent art; and
- D. Evaluate any objective indicia of nonobviousness. *MPEP §804.1*

The Examiner has rejected claim 1 as follows:

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U. S. Patent No. 6,722,569 (herein after referred as "the '599 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the essentially reciting the same limitations.

Similar to the claimed invention, claims 36, 43, 44 and 46 together recite: the step of capturing a first color image (base claim 35), storing the first color image (claim 46), capturing a second color image (base claim 42), decoding the image (claim 36), associating, displaying and linking (claims 43, 44 and 46).

The combination of claims 36, 43, 44, and 46 includes all limitations set forth in claim 1. It would have been obvious to combine the limitations of claims 36, 43, 44, and 46 into one single because they essentially are features of the same system. As can be seen, the patent protections have been granted to the earlier filed application. *May 4, 2004 Office Action, pps. 3-4.*

While the Examiner asserts that "The combination of claims 36, 43, 44, and 46 includes all limitations set forth in claim 1, the applicants have not found where the Examiner alleges that the claims of Ehrhart '569 sets forth at least the element of claim 1 of "displaying an image including the first color image and at least the decoded data."

Because the Examiner has at least not determined "the differences between the scope and content of the patent claim and the prior art as determined in "A" and the claim in the application at issue," the applicants respectfully assert that the rejection of claim 1 for obviousness type double patenting over Ehrhart '569 is improper and should be withdrawn.

The claims of the present application are believed to be directed to a different invention separate from the invention recited in parent U. S. Patent No. 6,722,569 to Ehrhart, et al. Accordingly, it is respectfully respected that the obviousness type double patenting rejection over Ehrhart '569 be withdrawn.

Regarding the rejections under 35 U.S.C. §112, the claims have been amended to address the rejections under 35 U.S.C. §112. The amendments to remove the rejections under 35 U.S.C. §112 are made to address a clerical error and should not be regarded as "narrowing" claim amendments.

Accompanying the present amendment is an Information Disclosure Statement including additional references for consideration by the Examiner. References submitted that are owned by the assignee of the present invention, such as U. S. Patent No. 6,834,807 (sharing a common specification with the present application and Ehrhart '569) or having an inventor in common with the present application should be considered for double patenting conflicts. All references submitted with one or both of the present inventors listed as an inventor are believed to be commonly owned with the present application, except that references with "Dueker" as an inventor along with "Ehrhart" and other inventors are believed to be assigned to more than one joint assignee with one of the joint assignees being the assignee of the present application. Patent applications with "Ynjiun Wang" as a listed

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inventor and having an earliest priority date of after November 2003 are also commonly assigned with the present application.

Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,

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